

Application No.: 09/817,123

Docket No.: 21987-00054-US

REMARKS

Claims 1-3 and 5-17 remain pending in this application. Claims 1-3, 5, 6, 16, and 17 are independent.

Claims 4, and 18-38 were canceled in the Preliminary Amendment, after prosecution in the Parent Application, ser. no. 09/060,106 filed on April 15, 1998.

Claims 2-3, 5, and 16, and 17 were previously withdrawn, as being directed to non-elected inventions.

Claims 1 and 6-15 now remain for prosecution in this Divisional Application. Claims 1, 6, 9, and 15 have been amended, and no claims have been added by this amendment.

Oath/Declaration

Although Applicant's stamped postcard receipt dated March 27, 2001 indicates that a combined declaration and power of attorney was filed, in response to the Examiner's comments in the Official Action, a copy of the declaration from the Parent Application is provided as an attachment to this amendment.

Unpatentability Rejections over Takemoto et al. and Hikawa et al.

Withdrawal of the rejections of claims 1, 6, and 7 under 35 U.S.C. §103(a) as being unpatentable over Takemoto et al. (US 5,741,184) in view of Hikawa et al. (US 5,526,306) is requested.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference must teach or suggest all the claim limitations.*<sup>1</sup> Further, the teaching or suggestion to make the claimed combination and the

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<sup>1</sup> See MPEP §2143.

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reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.<sup>2</sup>

At least with respect to independent claims 1 and 6, the applied art fails to teach or suggest all the claimed limitations.

Further, an essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references.<sup>3</sup> Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.<sup>4</sup>

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art."<sup>5</sup> Further with regard to the level of skill of practitioners in the art, there is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.<sup>6</sup> The level of skill in the art cannot be relied upon to provide the suggestion to combine references.<sup>7</sup>

### *Background of Applicant's Disclosure*

By way of background, the present application, in various aspects and embodiments, is directed to a game apparatus which is capable of efficiently recording and controlling advancement (playing) of a game, and to an information communication system which uses a multi-value memory and a control unit along with a game apparatus including game pieces with multi-value memory which at least stores game piece identification information.

<sup>2</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

<sup>3</sup> *C.R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225 (Fed. Cir. 1998)

<sup>4</sup> *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (Fed. Cir. 1985)

<sup>5</sup> *See* MPEP §2143.01, citing *In re Rouffet*, 149 F.3d, 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998).

<sup>6</sup> *Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980).

<sup>7</sup> *See* MPEP §2143.01, citing *Al-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).

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*Takemoto et al.*

Takemoto et al. is directed to a game hall system using a storage media and multiple game machines. Takemoto et al. does not teach or suggest use of "game pieces" or "game parts" which include embedded data carriers and/or memory devices, particularly multi-value memory devices.

The Examiner admits the deficiency of Takemoto et al. with respect to the type of memory uses, i.e., multi-value memory cell, etc.

The Examiner offers Hikawa et al. as teaching multi-valued memory cells.

*Hikawa et al.*

Hikawa et al. is directed to what appears to be conventional *binary* memory devices, and not *multi-valued* (i.e., three or more values) memory devices, as asserted by the Examiner.

Hikawa et al. offers a novel way of addressing the binary memory cells, by using sidewalls on side surfaces of word lines, among other features, and thereby providing different threshold values for various binary memory cells.

The Examiner refers to FIG. 38 and the Abstract of Hikawa et al. as supporting his assertion of a teaching of a multi-state memory device. Closer inspection of these portions of Hikawa et al. reveals, in FIG. 38, what appears to be a conventional binary memory address decoder to provide read/write access to particular binary memory cells in the memory cell array.

The Examiner's attention is directed to col. 31, lines 27-50 which discusses the address decoder, and also to the Abstract, which merely mentions that the memory cells may have different electrical properties.

Applicants submit that "different electrical properties" in a conventional binary memory cell array does not teach or suggest a multi-value memory cell having three or more states.

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*Deficiencies of Takemoto et al. and Hikawa et al.*

The applied art, taken alone or in combination, does not teach or suggest a game apparatus which includes, among other features, "a body..., *plural game pieces arranged on the body*, each of the plural game pieces including a data carrier having a control means for transmitting and receiving driving electric power and transferring the data between a respective one of said plural game pieces and said body, and *a multi-value memory in said each of the plural game pieces*, said multi-value memory containing identifying information [and being] being provided a plurality of multi-value cells, *each of said multi-value cells being capable of storing three or more predetermined values* relating to at least one of a particular game piece identification and sequential location information", as recited in independent claim 1, as amended (emphasis added).

Further, the applied art, taken alone or in combination, does not teach or suggest a information communication system which includes, among other features, "...a data carrier...*a multi-value memory* and a control unit...*a game apparatus [including] a body...and plural game pieces arranged on the body*, each of the plural game pieces including: a data carrier...and *a multi-value memory* containing at least identifying...said multi-value memory including a plurality of multi-value cells, *each of said multi-value cells being capable of storing at least one of three or more* predetermined values", as recited in independent claim 6, as amended (emphasis added).

Takemoto et al. does not teach or suggest plural game pieces each including a data carrier in each of the plural game pieces, and Hikawa et al. does not teach or suggest use of a multi-value memory.

Therefore, since the applied art does not teach or suggest all the limitations claimed in independent claims 1 and 6, withdrawal of the rejection and allowance of these claims is requested.

Further, since dependent claims 7-15 variously and ultimately depend from allowable claim 6, reconsideration and allowance of these dependent claims is also requested, without recourse to the additional patentable features recited therein.



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***Improper Motivation to Modify Takemoto et al. by Hikawa et al.***

Further, Applicant submits that proper motivation to modify Takemoto et al. by Hikawa et al. has not been established, since Hikawa et al. does not teach or suggest multi-value memory, such that a person with skill in the art would not turn to Hikawa et al. to solve Applicant's technical problem.

**Unpatentability Rejections over Takemoto et al., Hikawa et al., and Bergeron**

Withdrawal of the rejections of claims 8-14 under 35 U.S.C. §103(a) as being unpatentable over Takemoto et al. in view of Hikawa et al. and Bergeron (US 4,764,666) is requested.

The legal standard for unpatentability has been set forth above.

***Bergeron fails to Make up for the Deficiencies of Takemoto et al. and Hikawa et al.***

Bergeron is offered as teaching a contact terminal for transmitting and receiving information from/to programmable game entry cards used in an on-line wagering system.

Whether or not Bergeron teaches or suggest that for which it is offered by the Examiner, Bergeron does not make up for the previously identified deficiencies of Takemoto et al. and Hikawa et al., at least with respect to independent claim 6, from which dependent claims 8-14 depend.

Therefore, since the applied art, taken alone or in combination, does not teach or suggest all the claimed limitations, withdrawal of the rejection and allowance of claims 8-14 are requested.

**Unpatentability Rejections over Takemoto et al., Hikawa et al., and Zalewski**

Withdrawal of the rejections of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Takemoto et al. in view of Hikawa et al. and Zalewski (US 5,991,693) is requested.

The legal standard for unpatentability has been set forth above.

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***Zalewski fails to Make up for the Deficiencies of Takemoto et al. and Hikawa et al.***

Zalewski is offered by the Examiner as teaching a wireless apparatus and method of computer-assisted instruction including a plurality of wireless computer-tracked wireless bodies that are further capable of determining the positional relationship of the bodies, and which further uses this information to execute a process based upon this information.

Whether or not Zalewski teaches or suggest that for which it is offered by the Examiner, Zalewski does not make up for the previously identified deficiencies of Takemoto et al. and Hikawa et al., at least with respect to independent claim 6, from which dependent claim 15 depends.


Therefore, since the applied art, taken alone or in combination, does not teach or suggest all the claimed limitations, withdrawal of the rejection and allowance of claim 15 are requested.

**Unpatentability Rejections over Takemoto et al., Hikawa et al., and Zalewski**

In view of the above, each of the presently pending claims 1 and 6-15 in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

For any fee that is due with this Amendment, particularly with respect to fees for extensions of time, please charge our Deposit Account No. 22-0185, under Order No. 21987-00054-US from which the undersigned is authorized to draw.

Respectfully submitted,

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Encl: Copy of Declaration/Power of Attorney from Parent Application